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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,505	07/27/2001	Fabio Cinelli	CM-2016MC	9733

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EXAMINER

LEE, RIP A

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,505

Applicant(s)

CINELLI ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 31, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

This office action follows a request for continued examination under 37 CFR 1.114, filed on July 31, 2003. Applicants have amended claim 1. Claims 15-18 were canceled.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 1-11, 13 and 14 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/28014 to Cinelli *et al.*

Cinelli *et al.* teaches adhesives that have substantially gel-like structure and are preferably gels by virtue of the fact that the prevailing component is a plasticizer and due to the fact that a macromolecular/polymeric component is also present, which exists in the form of a three-dimensional network caused by crosslinking between molecules (page 12, lines 18-27). Adhesives of the invention are generally comprised of 45-99.5 wt % of plasticizer selected from water, alcohols, or glycols, and 0.5-20 wt % of a polymeric compound selected from polyacrylics, polyvinyl alcohols, polyethylene oxides, and polyvinyl pyrrolidones (claims 5 and 6; note that these compounds coincide with the compositional requirements set forth in present claims 10, 13, and 14). Furthermore, the reference states that mixed phase compositions are preferred for adhesives of the invention (page 14, line 21). A mixed phase composition is one in which both hydrophobic and hydrophilic components, possibly in both plasticizers and polymers, form two or more separate phases (page 4, lines 8-10). Thus, the subject matter of present claim 11 is also covered in the prior art.

Although Cinelli *et al.* describes formation of chemical crosslinks by condensation reactions or *via* added crosslinking agent rather than by irradiative methods, one notes that the use of low energy radiation is recited in the claim in product by process form. In absence of any showing that the method by which the adhesive polymer is crosslinked results in a significantly different product, it is maintained that the subject matter of the present claim 1 is still met by the prior art. Where product by process claims are rejected over a prior art product that appears to

be the same, the burden is shifted to the Applicant to establish an unobviousness difference, even if the production processes are different. *In re Marosi*, 218 USPQ 298 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests on the product formed, not on the method by which it was produced. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

The adhesives in Cinelli *et al.* are characterized by the parameters  $G''_{25}$ ,  $G'_{37}$ , and  $G''_{37}$ . The viscous modulus is related to thickness  $C$  according to the equation  $G''_{25} \leq [(4.26 + C)1605]$  Pa (claim 1). Regardless of the value of  $C$ , the value of  $G''_{25}$  will be less than that imposed in present claims 5 and 6. The adhesive also possesses  $G'_{37}$  in the range of 1500-20,000 Pa and  $G''_{37}$  in the range of 100-15,000 Pa. These ranges lie squarely within the ranges set forth in present claim 7, and they overlap substantially the ranges set forth in present claims 8 and 9.

The reference is silent with respect to the initial peel strength,  $P_I$ , and final peel strength,  $P_F$ , of the adhesives. Since peel strength is an inherent property of adhesives, and since the prior art material is an adhesive, it follows that the prior art adhesive also possesses peel strength. As such, there is every expectation to believe that this property can be measured according to the method of the present application. Since the prior art material and that of the present invention have essentially the same composition, as evidenced by their exhibiting essentially the same rheological properties  $G''_{25}$ ,  $G'_{37}$ , and  $G''_{37}$ , a reasonable basis exists to believe that they would display essentially the same initial and final peel strength described in present claims 1-4. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

The reference is also silent with respect to the water absorption capacity of the adhesive. However, in view of the fact that the adhesive is essentially the same as that presently claimed (*vide supra*), and in view of the fact that the adhesive is comprised mainly of hydrophilic components, a reasonable basis exists to believe that it displays essentially the same water absorption capacity. Again, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cinelli *et al.* in view of EP 0 850 649 to Coles *et al.*

Although Cinelli *et al.* teaches composition containing both hydrophobic and hydrophilic components, the inventors do not indicate practical working ratios of the two components. Coles *et al.* shows that adhesives containing 30-70 wt % of hydrophilic components and 30-70 wt % of hydrophobic components affords satisfactory adhesives which exhibit properties,  $G'_{37}$ , and  $G''_{37}$  that meet the requirements set forth in the present claims. Therefore, one having ordinary skill in the art, having understood the subject matter of the two references, would have found it obvious to use the hydrophilic-hydrophobic ratio taught in Coles *et al.* in order to arrive at present claim 12. One would have found it obvious to combine the teachings because both references teach adhesive compositions containing hydrophilic and hydrophobic components and having the same rheological properties.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cinelli *et al.* in view of WO 96/33683 to Lichstein.

Cinelli *et al.* does not teach the amount of adhesive to be applied to the wearer facing surface of the disposable absorbent article. Lichstein shows that an adhesive coating weight of 2 mg/cm<sup>2</sup> (claim 12) is suitable for the wearer facing surface of disposable absorbent articles (claims 1 and 2). Thus, it would have been obvious to one having ordinary skill in the art to use a coating weight of 2 mg/cm<sup>2</sup>, as taught by Lichstein, in order to arrive at the claims of the present invention. One would have found it obvious to do so because this amount is adequately disclosed in the reference.

7. Claims 1-11, 13 and 14 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/28021 to Cinelli *et al.*

Cinelli *et al.* discloses an adhesive comprising a polymer selected from polyacrylics, polyvinyl alcohols, polyethylene oxides, and polyvinylpyrrolidones, their copolymers and derivatives, and a plasticizer selected from water or (poly)glycols (claim 6). The topical adhesive of the invention has a substantially gel-like structure or is a gel (page 14, lines 23) by virtue of a three-dimensional network caused by physical or chemical crosslinks between molecules (page 14, line 30). Cinelli *et al.* instructs that mixed phase compositions in which both hydrophilic and hydrophobic components form two or more separate phases (page 16, lines 9-11), and stress further that mixed phase compositions are preferred in the applications of their invention (page 16, line 22).

Although Cinelli *et al.* describes formation of chemical crosslinks by condensation reactions or *via* added crosslinking agent rather than by irradiative methods, one notes that the use of low energy radiation is recited in the claim in product by process form. In absence of any showing that the method by which the adhesive polymer is crosslinked results in a significantly different product, it is maintained that the subject matter of the present claim 1 is still met by the prior art. Where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to the Applicant to establish an unobviousness difference, even if the production processes are different. *In re Marosi*, 218 USPQ 298 (Fed. Cir. 1983). Furthermore, the patentability of a product claim rests on the product formed, not on the method by which it was produced. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

The adhesive of Cinelli *et al.* is characterized by  $G'_{37}$  in the range of 1500-20,000 Pa and  $G''_{37}$  in the range of 100-15,000 Pa, such that the ratio of  $G'_{37}$  to  $G''_{37}$  is 3 to 30 (claim 3), and by viscous modulus  $G''_{25}$  wherein  $G''_{25} \leq [(4.26 + C)1605]$  Pa (claim 1). These ranges overlap substantially the ranges set forth in present claims 5- 9. In light of the fact that the constitution of the adhesive of the prior art and the present invention are essentially the same, and in view of the fact that they have the same properties  $G'_{37}$ ,  $G''_{37}$ , and  $G''_{25}$ , a reasonable basis exists to believe that the prior art adhesive would exhibit peel strengths  $P_I$  and  $P_F$  recited in present claims 1-4. Since the PTO does not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.



The reference is also silent with respect to the water absorption capacity of the adhesive. However, in view of the fact that the adhesive is essentially the same as that presently claimed (*vide supra*), and in view of the fact that the adhesive is comprised mainly of hydrophilic components, a reasonable basis exists to believe that it displays essentially the same water absorption capacity. Again, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

#### ***Response to Arguments***

8. The following rejections, which remained outstanding in the advisory action, have been withdrawn:
- (i) rejection of claims 1-11 and 13-18 under 35 U.S.C. 103(a) over WO 98/28014 to Cinelli *et al.* in view of GB 2 115 431 to Sieverding,
  - (ii) rejection of claim 12 under 35 U.S.C. 103(a) over Cinelli *et al.* in view of Sieverding and further in view of Coles *et al.*,
  - (iii) rejection of claim 19 under 35 U.S.C. 103(a) over Cinelli *et al.* in view of Sieverding and further in view of WO 96/33683 to Lichstein, and
  - (iv) rejection of claims 1-11 and 13-18 under 35 U.S.C. 103(a) over WO 98/28021 to Cinelli *et al.* in view of Sieverding.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

ral

August 27, 2003



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